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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,898	06/27/2003	Chris Graham	MSFT-2152/304791.1	7218

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)  
CIRA CENTRE, 12TH FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

EXAMINER

OSMAN, RAMY M

ART UNIT PAPER NUMBER

2157

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/607,898

Applicant(s)

GRAHAM ET AL.

Examiner

Ramy M. Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is responsive to application filed on June 26, 2003. Claims 1-22 are pending examination.

### ***Drawings***

2. The drawings filed on 7/11/2003 are acknowledged and are objected to. The drawings contain some unreadable text.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 9/29/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is not seen how the cited patents are relevant to the instant application. Furthermore Applicant has not included a statement of relevance in compliance with 37 CFR 1.98 (3) (i). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12 and 19 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A statutory computer process is determined not by how the computer performs the process, but by what actions the computer performs to achieve a practical application with a useful, concrete and tangible result. The claims are presented simply as a program per se which consists of software instructions without a physical tangible output result that is conveyed to a user in a real-world application of the tangible results. The claims are non-statutory because applicant is claiming an intangible software program per se and because they do not claim a practical application within an executable environment that would produce a tangible result. (*see MPEP Section 2106(IV)(C)*).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain reference identifiers, such as "(PU-RM)" etc., which are undefined and seem to refer to unspecified figures. The reference identifiers are inappropriate as claim language because they render the claim unclear and grammatically incorrect.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1,2,5,6,8,10,12,13,16,17,19,21 rejected under 35 U.S.C. 102(e) as being anticipated by Ranzini et al (US Patent No 7,120,606).**

8. In reference to claim 1, Ranzini teaches a rights-managed email for sending protected content from a sender to a recipient, whereby the recipient can render the protected content with a corresponding license if the recipient satisfies terms set forth in the license, the email comprising:

a main information portion having a message that the email is rights management protected (column 9 lines 22-30 & 57-60, Ranzini discloses a message that indicates an attachment portion that requires recipient authentication); and

an attachment portion having the protected content, wherein the recipient if enabled can render the protected content in the attachment portion and if not enabled can only review the main information portion having the message (column 9 line 57 – column 10 line 7).

9. In reference to claim 2, Ranzini teaches the email of claim 1 wherein the attachment portion further has rights data relating to the protected content, the rights data setting forth each entity that has rights with respect to the protected content, and for each such entity a description of such rights (column 6 lines 55-67).

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10. In reference to claim 5, Ranzini teaches the email of claim 1 wherein the protected content in the attachment portion comprises multiple alternative forms of a body of the email, whereby the recipient can select from among the alternative forms when rendering the protected content (column 10 lines 8-67).

11. In reference to claim 6, Ranzini teaches the email of claim 1 wherein the protected content in the attachment portion comprises a body and an attachment list, the attachment list including preface information, at least one attachment to the body, and any metadata relating to each attachment of the body (column 10 lines 8 –67).

12. In reference to claims 12,13,16,17, these claims teach a computer readable medium that correspond to the method claims of claims 1,2,5,6. Therefore, claims 12,13,16,17 are rejected based upon the same rationale as given for the rejections of claims 1,2,5,6.

13. In reference to claims 8,10,19,21, these claims teach a method and computer readable medium respectively, that correspond to the method claims of claims 1,2,5,6. Therefore, claims 8,10,19,21 are rejected based upon the same rationale as given for the rejections of claims 1,2,5,6.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 3,4,7,9,11,14,15,18,20,22 rejected under 35 U.S.C. 103(a) as being unpatentable over Ranzini et al (US Patent No 7,120,606) in view of Beck et al (US Patent No 5,903,723).**

16. In reference to claim 3, Ranzini teaches the email of claim 2. Although Ranzini teaches various content security methods (column 9 lines 57-67), Ranzini fails to explicitly teach wherein the protected content in the attachment portion is encrypted according to a cryptographic key, and the rights data includes a decryption key (KD) for decrypting the encrypted content. However, Beck teaches transmitting an attachment that is encrypted along with its decryption key for the purpose of securing the attachment so that only the intended recipient can render the attachment (column 7 lines 19-40). It would have been obvious for one of ordinary skill in the art to modify Ranzini wherein the protected content in the attachment portion is encrypted according to a cryptographic key, and the rights data includes a decryption key (KD) for decrypting the encrypted content as per the teachings of Beck for the purpose of securing the attachment so that only the intended recipient can render the attachment.

17. In reference to claim 4, Ranzini teaches the email of claim 3. Although Ranzini teaches various content security methods (column 9 lines 57-67), Ranzini fails to explicitly teach wherein the decryption key (KD) is encrypted according to a public key of a rights management (RM) server (PU-RM) operated by or on behalf of an organization of the sender to result in (PU-RM(KD)), where only the RM server can access (KD) from (PU-RM(KD)) with a corresponding private key (PR-RM). However, Beck teaches utilizing v encryption techniques including encrypting the decryption key according to a public key for the purpose of securing the attachment so that only the intended recipient can render the attachment (column 7 lines 19-40).

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It would have been obvious for one of ordinary skill in the art to modify Ranzini wherein the decryption key (KD) is encrypted according to a public key of a rights management (RM) server (PU-RM) operated by or on behalf of an organization of the sender to result in (PU-RM(KD)), where only the RM server can access (KD) from (PU-RM(KD)) with a corresponding private key (PR-RM) as per the teachings of Beck for the purpose of securing the attachment so that only the intended recipient can render the attachment.

18. In reference to claim 7, Ranzini teaches the email of claim 1. Ranzini fails to explicitly teach wherein the protected content in the attachment portion is compressed to reduce an overall size thereof. However, Beck teaches compressing attachments for the purpose of minimizing storage space for transmitting to a recipient (column 6 lines 37-50). It would have been obvious for one of ordinary skill in the art to modify Ranzini wherein the protected content in the attachment portion is compressed to reduce an overall size thereof as per the teachings of Beck for the purpose of minimizing storage space for transmitting to a recipient.

19. In reference to claims 14,15,18, these claims teach a computer readable medium that correspond to the method claims of claims 3,4,7. Therefore, claims 14,15,18 are rejected based upon the same rationale as given for the rejections of claims 3,4,7.

20. In reference to claims 9,11,20,22, these claims teach a method and computer readable medium respectively, that correspond to the method claims of claims 3,4,7. Therefore, claims 9,11,20,22 are rejected based upon the same rationale as given for the rejections of claims 3,4,7.

### ***Conclusion***

21. The claims have been given their broadest reasonable interpretation. Applicant is advised that the above specified citations of the relied upon prior art are only representative of the



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teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and priority documents) is implied as being applied to teach the scope of the claims.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO  
March 3, 2007

  
ABDULHADI SALAD  
PRIMARY EXAMINER